REMARKS

Reconsideration and withdrawal of the rejections of the application are requested in view of the amendments and remarks presented herein, which place the application into condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-21 and 24 are pending in this application. Claims 1-19, 21 and 24 are amended for clarity and to place the claims in better form. No new matter is added.

It is submitted that these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments of the claims herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather, the amendments are made simply for clarification and to round out the scope of protection to which Applicants are entitled. Furthermore, it is explicitly stated that the herewith amendments should not give rise to any estoppel, as the herewith amendments are not narrowing amendments.

II. THE DOUBLE PATENTING REJECTION IS OVERCOME

Claims 1-21 and 24 were rejected under the judicially created doctrine of double patenting over claims 1-10 of U.S. Patent No. 6,541,248 ("the '248 patent") as allegedly improperly extending the right to exclude already granted in the patent. The rejection is traversed.

The Office Action alleges, on page 3, that "the patent and the application are claiming common subject matter" because "[t]he patent claims a lentiviral vector system and the instant application claims a viral vector system comprising essentially the same elements." The Office Action goes on to state that "there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent." These assertions are incorrect.

The claims of the '248 patent are directed to a lentiviral vector system, while the instant claims are more broadly directed to a viral vector system. In addition, the first nucleotide sequence of claim 1(i) in the '248 patent encodes an anti-sense RNA or a ribozyme, whereas the first nucleotide sequence of claim 1(i) in the current application encodes an external guide sequence. As is disclosed on page 1, lines 24-25 of the instant application, anti-sense RNA, ribozymes and external guide sequences are all different types of inhibitory RNA molecules.

While the '248 patent discloses and claims nucleotide sequences encoding anti-sense RNA and ribozymes, it does not disclose the use of external guide sequences, as disclosed and claimed in the instant application. Therefore, contrary to the assertion in the Office Action, Applicants were, in fact, "prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent" because there was not adequate support in the '248 patent for the first nucleotide sequence to be an external guide sequence, as is required by current claim 1.

Consequently, reconsideration and withdrawal of the double patenting rejection are requested.

CONCLUSION

In view of the remarks herewith, it is believed that the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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